

Serial Application No. 08/850,353
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Remarks/Arguments

Amendments:

Claims 3 and 16 are currently pending. Both have been amended to claim ziprasidone as the medicinal compound. Support for said amendment can be found on at least page 10, lines 12-18.

Claims 17 and 18 are new. These are claims 1 and 2, respectively, reinstated and amended to claim ziprasidone as the medicinal compound. Support for said amendment can be found on at least page 10, lines 12-18.

Rejections:

Rejection based on 35 USC § 102(a):

Claims 3 and 16 had been rejected under 35 USC § 102(a) as being anticipated by Chiese et al (US Patent No. 5,773,029) for the reasons disclosed on pages 3-5 of the Office Action mailed November 20, 2003.

Applicant unsuccessfully traversed the rejection in the response filed November 14, 2005. Applicant continues to disagree with said rejection; however, Applicant has amended the pending claims to advance prosecution. Applicant specifically reserves the right to file a subsequent application on the canceled subject matter.

The 11/20/2003 Office Action has been referenced as providing the basis of the rejection, different sections of Chiese, '029 are presented on pages 3-5, concluding with the statement: "The method described in the Chesi, '029 for preparing multicomponent inclusion complexes anticipate the method of locating one or more salts of a compound and a method of determining a useful salt from within a series of salts as instantly claimed."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1063 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP2131.02 "The identical invention must be shown in as complete detail as is contained in the claim." *Richland*

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v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1931, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but is not an *ipse dixit* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01. [MPEP 2131.]

.... The anticipating reference must contain within its four corners a sufficient description to enable one to practice the invention without experimentation or inventive skill. *Phillips Elec. & Pharmaceutical Indus. Corp. v. Thermal & Elec. Indus. Inc.*, 450 F.2d 1164, 1169, 171 USPQ 641, 644-45 (2d Cir. 1971); *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 990, 52 USPQ 138, 142-43 (2d Cir. 1942); *I Chisum, Patents* § 3.04[1][6] (1985). See *CBS v. Sylvania Electric Prod., Inc.*, 415 F.2d 719, 725, 162 USPQ 577, 581 (1st Cir. 1969) (test is whether the prior art reference "describes the invention with sufficient clarity and specificity so that one skilled in the art may practice the invention without assistance from the patent claimed to have been anticipated.") [*Schering Corp. v. Precision-Cosmet Co., Inc.*, 614 F Supp 1368, 227 USPQ 278, 281 (D Del, 1985).]

Within *Cheisi*, '029, no discussion or reference is found to ziprasidone. Therefore, *Cheisi*, '029 cannot anticipate the pending claims.

Conclusion

Applicant requests granting of the RCE and believes that the claims are in order for allowance, early notice of which is requested. If Examiner has any questions concerning this application, Examiner is invited to contact the below-signed attorney. The Commissioner is hereby authorized to charge the amount of \$790 for the RCE as provided for under 37 C.F.R. 1.17, as well as any additional fees required, or to credit any overpayment to Deposit Account No. 16-1445.

Respectfully submitted,

Mary J. Hosley

Mary J. Hosley, Attorney; Registration No. 48,324
Corporate Counsel

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Pfizer, Inc
150 East 42nd Street, Floor 5
New York, NY 10017-5612
Telephone No. 212.733-0460
Telefax No. 212.573-1939